

REMARKS/ARGUMENTS

I. Status of the Application

Prior to entry of this response, claims 1-51 are pending in this application. The most recent office action (Paper #14), dated July 18, 2003, rejected claims 1-51 under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,805,587 (Norris) and U.S. Patent No. 6,498,841 (Bull). This response neither adds, amends nor cancels and claims, so after entry of this response, claims 1-51 will remain pending in the application.

II. Claim Rejections

Claims 1-51 have been rejected under § 103(a) as being unpatentable over Norris, in view of Bull. The applicant respectfully traverses these rejections, and submits the following arguments in support of his position.

In an earlier office action (Paper #12), the claims were rejected as unpatentable over the combination of Norris and U.S. Patent No. 5,796,806 (Birckbichler). In response (Paper #13), the applicant argued that Norris and Birckbichler permissibly could not be combined in the contemplated manner to create a *prima facie* showing of obviousness, for a variety of reasons. For instance, the applicant argued that the references cannot be combined in any operable manner to teach the limitations of the claims in this application. Birckbichler teaches the use of the public switched telephone network (PSTN), and in particular, the components of an advanced intelligent network (AIN), to provide a spoken caller ID service, which Norris teaches the use of a data network, separate from the PSTN, to provide a call waiting notification via a computer. The Examiner found these arguments persuasive, and the most recent office action therefore withdrew the rejections based on the combination of Norris and Birckbichler.

The most recent office action, continued to reject the claims but substituted Bull for Birckbichler as the secondary reference. These new rejections are somewhat confusing, because the combination of Norris and Bull appears to suffer from the same deficiencies as the combination of Norris and Birckbichler, which, as the office action correctly recognizes, fails to create a *prima facie* case of obviousness. Like Birckbichler, Bull teaches a voice system for

providing enhanced caller notification. Also like Birckbichler, the embodiment of Bull cited in the office action teaches the use of an AIN to implement the system. Concededly, Bull (col. 3, lns. 11-20) mentions in passing that “[a]lternatively, they system 100 can be implemented in a computer network or any other network that is adapted to store and receive information.”

Notwithstanding this boilerplate statement, however, nothing in Bull would enable one skilled in the art to practice Bull’s invention (an in particular the audible caller identification function at issue here) outside the context of the PSTN, and specifically, an AIN. Other than the use of known PSTN (and particularly, AIN) components, Bull fails to provide any description of how one might implement the caller ID features cited by the office action. And, as described in the applicant’s prior response, the combination of Norris with any PSTN-based caller-identification system would not be operable, or at the very least would change dramatically Norris’ principle of operation.

Further, it is difficult to contemplate how the disclosures of Bull and Norris, even if combined, would teach or even suggest the claimed invention in the present application. For instance, claim 1 recites, *inter alia*, “receiving an audible identification from the caller; and . . . providing the audible identification via the computer network and the subscriber line to the device.” The office action asserts that “Bull teaches the steps of collecting the caller audible identification and sending the collected audible identification to the device.” The cited portion of Bull (col. 6, ln. 63 – col.7 ln. 12) teaches only the use of well-known AIN components to perform this function, however:

“[A]t step 304, the calling party is prompted to audibly provide spoken caller identification information. SCP 206 access database 208 to retrieve call control information and returns the call control information to SSP 202. . . . In response to the call control information, SSP 202 routes the call to SN/IP 212. When SN/IP 212 receives the call, SN/IP generates a request for spoken caller identification that is transmitted to the calling telephone station 220. . . . If the calling party provides an audible response, SN 250 or IP 29 enables the audible response to be transmitted to calling station 222 as audible caller identification.”

Clearly, therefore, Bull, like Birckbichler, teaches that the PSTN retains control of the call during the steps of obtaining audible caller identification and providing that

identification to the called station. Indeed, nothing in Bull's disclosure would teach one skilled in the art to use anything but AIN components to perform these functions.

On the other hand, as noted in the previous response, Norris (col. 5, lns. 53-64) contemplates forwarding the call out of the PSTN to a separate data network, whereby,

“CO 25 determines that station S1 is busy and that call forwarding has been activated at station S1. As such CO 25, in a conventional manner, directs the call to IAS 200 in accord with the call forwarding telephone number that CO 25 received as interacting with IAS 200 in the manner discussed above. In doing so, CO 25 sends a message to TS 105 requesting a rerouting of the station S2 call and containing the IAS 200 telephone number as the destination for such rerouting.”

(emphasis added).

Hence, the system of Norris operates by forwarding the incoming call out of the PSTN to a separate Internet Access Service (200), according to the telephone number of the IAS. As noted in the applicant's previous response, the IAS clearly is not a part of the PSTN, as shown by both the above-quoted passage and Fig. 1 of Norris. Thus, the only role of the PSTN in Norris' system is to forward the call to a separate Internet Access Service, which even has its own telephone number. In other words, the telephone network does little (if anything) but determine that the subscriber is online, and if so, forward calls to the Internet Access Service. Thereafter, the IAS handles the notification of the subscriber, as well as controls the disposition of the call. As discussed in the prior response, the IAS is not part of the PSTN and thus would not be considered an Intelligent Peripheral. Instead, the IAS is a separate service (sitting outside the PSTN) that the subscriber uses to connect to the Internet. *See* Norris, col. 2, lns. 15-20; Fig. 1.

Thus, while Bull teaches the use of the PSTN (and specifically, an AIN) to perform Bull's spoken caller ID function, Norris teaches away from using an intelligent network (or any other PSTN) to perform its online notification function; while Norris' system uses the PSTN to forward calls to the IAS, it is the IAS (which, as discussed above, is separate from the PSTN) that actually performs the online notification. Norris, therefore, teaches away from using a voice network (and, specifically, a service node and/or intelligent peripheral) to perform its notification function, while Bull (like Birckbichler) requires a voice network for its own spoken

caller ID feature. Norris, in effect, teaches away from any combination of that reference with Bull.

In fact, as with the attempted combination of Birckbichler and Norris, it is difficult to see how the two disparate systems of Bull and Norris could be combined at all with any reasonable expectation of success. For instance, in the system of Norris (col. 4, lns. 22-60), the call-forwarding feature is activated when the subscriber goes online, before any incoming call ever is received, such that an incoming call is forwarded automatically to the IAS, which assumes further control of the call. That automatic forwarding and control feature, however, which is critical to the operation of Norris, would prevent the SN/IP of Bull from accessing the incoming call and performing its functions (collecting information from the caller and audibly informing the subscriber about the caller's information), rendering any combination of Norris and Birckbichler inoperable. For this additional reason, the asserted combination fails to create a *prima facie* case of obviousness under §103.

In contrast, as discussed in the prior response, the present application does teach, *inter alia*, a novel way to use/modify an AIN to provide audible notification to a subscriber while that subscriber is online. At the very least, therefore, the present application provides the necessary disclosure to fill the gap between the teachings of Norris and Bull (or Birckbichler, for that matter). Thus, it is only the disclosure of the present application that teaches an operable system for providing audible caller identification via a computer network and subscriber line.

The inventive concepts in the present application provide several benefits over both Norris and Bull. For instance, because, in certain aspects, the present application does not require the transfer of a call outside the PSTN to provide call waiting functionality (as does Norris), common AIN components can be used, allowing, *inter alia*, for more flexibility in call-handling options. Merely by way of example, in an embodiment disclosed at page 7, lines 15-20 of the application, after listening to the audible identification of the caller, the subscriber can choose to take the call either over the Internet or via the subscriber line. This feature presumably is unavailable in the system of Norris: Once the call has been forwarded to the IAS, the only way Norris (*see* col. 7, ln.1 through col. 8, ln. 5) discloses for the subscriber to take the call is via

Internet telephony; because the IAS, not the PSTN, now handles the call, there would be no way for the subscriber to take the call via the subscriber line. Clearly, in forwarding the call to the separate Internet Access Service, Norris operates fundamentally differently than, for example, Bull and Birckbichler, in which the PSTN maintains control over the call. As discussed above, therefore, any combination of Norris with Bull or Birckbichler necessarily would be inoperable or, at the very least, would fundamentally change Norris' principle of operation.

Like Birckbichler, therefore, Bull cannot be combined with Norris in the manner contemplated by the office action. In fact, the disclosures of Norris and Bull teach away from their combination, eliminating any possible motivation that the art could provide to combine the references. Indeed, the combination of Norris with Bull would meet with no reasonable expectation of success, so even if there were some motivation or suggestion to attempt to combine the references (and, as noted above, there is not), that combination would fail to create a *prima facie* case of obviousness with respect to the claims of the present application. For at least these reasons, the applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

Appl. No. 09/606,617
Amdt. dated 10/20/03
Reply to Office Action of 07/18/2003

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and respectfully requests a formal Notice of Allowance at an early date.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Chad E. King
Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
Attachments
CEK:nmb
60043421 v1